

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#25

In re application of: Goodman et al.

Group Art Unit: 1647

Serial No. 08/971,172

Examiner: Turner, S.

Filed: November 14, 1997

Attorney Docket No. B98-006-2

For: *Robo: A Novel Family of
Polypeptides and Nucleic Acids*

CERTIFICATE OF TRANSMISSION

I hereby certify that this corr is being transmitted by facsimile to the
Comm for Patents at (703) 305-8825 on June 19, 2001.

Signature

Richard Aron Osman

RECEIVED

2001 JUN 19 PM 3:32

OFFICE OF THE
COMMISSIONER FOR PATENTSPETITIONThe Commissioner for Patents
Washington, DC 20231

Dear Commissioner:

I submit that the Commissioner has exhausted his statutory authority to reject the claims of this patent application; I petition for immediate allowance of all pending claims.

Our laws provide a very clear statutory procedure for examining patent applications: 35USC131 provides that the Commissioner shall cause "an examination" of a patent application. 35USC132 provides that if, on this examination, any claim is rejected, the Commissioner shall notice the Applicant of the reasons for rejection including relevant references, whereafter if Applicant persists in his claim, the application shall be reexamined. 35USC134 provides that an Applicant whose claims have been thus twice rejected, may appeal to the Board of Appeals and Interferences; and 35USC141 provides that an Applicant dissatisfied with a Board decision, may appeal to the Federal Circuit.

This statutory procedure limits the statutory authority of the Commissioner to reject patent claims: they shall be subject to an examination at which point the Commissioner may reject them only with cause and notice. If the Applicant persists, the Commissioner shall reexamine the claims, at which point he may maintain the rejection. At that point, the Applicant may abandon his effort or appeal the rejection, first to the Board, and if still dissatisfied, to the

Federal Circuit.

This statutory procedure provides important safeguards for the Commissioner, the Applicant and the Public. One safeguard it provides the Applicant is from endless administrative obstructions to obtaining a lawful patent. The law only authorizes the Commissioner to twice examine and twice reject an application. If otherwise, the Commissioner could effectively deny an Applicant's lawful right to a patent by endlessly examining and rejecting an application and then deny Applicant's statutory right to appeal to the Board by endlessly reopening prosecution.

The US Patent and Trademark Office rules are generally consistent with the laws. 37CFR1.104 implements the examination authorized by 35USC131; 37CFR1.112-1.113 implement the re-examination authorized by 35USC132; and 37CFR1.191-1.198 implement the appeal process prescribed by 35USC134.

However, there are two instances where the rules appear inconsistent with the law by implying that the Commissioner may examine and reject claims beyond the limited statutory authority vested in him under 35USC131 and 35USC132. For example, while 37CFR1.104(b) provides that an Examiner's Action under 37CFR1.104(a) "*will be complete as to all matters*", the re-examination provision, 37CFR1.113, is directed to a second "*or any subsequent examination*". No statutory authority is provided for these unspecified subsequent examinations and they are clearly proscribed by the statutory procedure of 35USC131 and 35USC132. The other instance of apparent ultra vires rule making is in 37CFR1.193(b)(2) which appears to permit the Examiner to reopen prosecution after an appeal has been filed. This procedure would deny the Applicant his statutory right to have his appeal considered by the Board. Furthermore, it provides no restraint against repeated usage - there is nothing in the rule that prevents the Examiner from eternally frustrating the Applicant by endlessly reopening prosecution. There is no statutory authority for such post-appeal re-examinations and they are clearly proscribed by the statutory procedure of 35USC131 and 35USC132.

Here, Applicants' claims have been examined and rejected beyond that authorized by 35USC131 and 35USC132. Instead of being examined and reexamined as permitted by law, this application has been examined over and over and over and over again. This application was filed on 11/14/97. To date, the Examiner has issued first, second, third, fourth and fifth

substantive actions on the merits (mailed 3/5/99, 10/14/99, 1/21/00, 5/10/00 and 3/27/01); and the latest action raises yet new issues and is made non-final. Furthermore, the Office's implementation of appellate procedure under 35USC134 offers no remedy where the Office routinely declines to answer appeals, but instead simply reopens prosecution under 37CFR1.193(b)(2), a practice which the undersigned encounters with *most* of the appeals he files in this technology center and a practice to which the present Examiner (Turner) and Supervisor (Kunz) have personally subjected the undersigned in copending applications¹. This application has been pending for more than 43 months, has been subject to five consecutive Actions on the merits, and the Examiner is still raising new issues, necessitating yet another Action. Our statutory framework for patent prosecution does not subject Applicants *nor Examiners* to a standard of perfection, wherein claims are examined over and over, leaving no stone unturned, until there is no reasonable doubt of patentability. Rather Congress has provided a balance between Applicant's Constitutional right to an expeditiously issued patent and a reasonable basis for the accompanying statutory presumption of validity. That balance is defined by 35USC131, 132 and 134, whereby an application is examined up to two times, whereafter Applicant is entitled to Board review.

Finally, I believe that strict compliance with the statutory framework of 35USC131-134 will result not only in better prosecution, but also in better patents. Ironically, it may also ultimately generate more fees for the USPTO, as practitioners will be motivated to file Requests for Continued Examination (RCE's) rather than allow their patents to issue with any outstanding question of patentability which might otherwise show up in the prosecution history or in the Examiner's reasons for allowance, and promoting RCE practice would also permit Examiners to be adequately time and resource compensated for further examinations.

In any event, if the Commissioner does not intend to grant this petition, the undersigned requests that it be promptly denied with accompanying reasoning explaining what statutory

¹ Serial numbers are omitted as kindly suggested by Robert Bahr, to avoid cross-referencing unrelated applications; however, at the Commissioner's request, the undersigned would be pleased to provide a record verifying the frequency that appeals filed by the undersigned are not answered.

safeguards the Office has in place to prevent an Applicant from being subject to endless prosecution and/or from being denied access to the Board of Appeals by repeated reopenings of prosecution. Applicant also solicits guidance from the Commissioner on how, working in concert with the Office, we can most expeditiously seek judicial guidance on whether 35USC131, 132 and 134 provide such statutory safeguards and whether 37CFR1.193(b)(2) is consistent with those laws.

The Commissioner is hereby authorized to charge any fees or credit any overcharges relating to this communication to my Deposit Account No. 19-0750 (order B98-006-2).

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP


Richard Aron Osman, Ph.D., Reg. No. 36,627
Tel: (650) 343-4341; Fax: (650)343-4342